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Steven P. O'Connor
FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P
1 BECTON DRIVE, MC 110
FRANKIN LAKES, NJ 07417-1880

In re Application of	:	
RAMBACH et al.	:	
Serial No.: 10/528,824	:	Decision on Petition
Filed: March 23, 2005	:	
Attorney Docket No.: 10618.0004	:	

This letter is in response to the Petition under 37 C.F.R. 1.181 and 1.144 filed on October 28, 2008 requesting withdrawal of the restriction requirement.

BACKGROUND

This application was filed as a national stage application under 35 USC 371 of PCT/FR03/02788 and as such, is eligible for unity of invention practice.

On July 31, 2006, the examiner mailed to applicants a non-final Office action examining all pending Claims 1-12 and 14-16 including claims to methods, claims to products and claim 6 to the particular antibiotics instantly claimed. The claims were rejected under 35 U.S.C. 102 and 35 U.S.C. 103.

On October 25, 2006, the applicant responded to the non-final Office action and filed amendments to the independent claim 1 that listed in the alternative the particular antibiotics of the instant claims.

On January 29, 2007, the examiner mailed to applicants a second non-final Office action rejecting all of the then pending claims and including 4 different rejections set forth under 35 U.S.C 103(a).

On April 30, 2007, the applicant filed a response and amended the claims.

On July 11, 2007, the examiner mailed a Final Office action to applicants, again rejecting all the pending claims.

On January 10, 2008, the applicant filed a request for continued examination, amended claims and presented arguments.

On February 21, 2008, the examiner mailed a restriction requirement separating a first method (claims 52-77) from a second method (claims 78-98). The examiner provided the following reasons for requiring restriction to a single method:

> Invention I is patentably distinct from Invention II since the compounds employed are distinct from each other.

The examiner further stated that there would be a serious burden on the examiner if restriction were not required. The examiner further required various elections of species. Moreover, the examiner considered Claims 17-51 (drawn to gelled culture mediums) to contain new matter and objected to the claims stating they will not be considered. The already examined Claims 17-51 were left out of all groups and not offered to applicants as a choice for election.

March 18, 2008, applicant requested that the Office withdraw the new matter objection and examine the claims 17-51 (the product claims) on the merits. However, in response to the restriction requirement, applicant elected Group I, claims 52-77 (method claims) with traverse and argued that the claims now under restriction had been previously substantively examined together.

On June 13, 2008, the examiner mailed to applicant a non-final Office rejection. The examiner withdrew claims 52-98, including elected claims 52-77, as being drawn to nonelected inventions and withdrew claims 29-30 and 37-51 as being drawn to nonelected species. The examiner stated that Claims 17-28, 31-34 and 36 are drawn to the elected invention and species. The examiner made the restriction requirement Final.

On October 28, 2008, applicants filed this petition to request that the Office reconsider the restriction requirement, responded to the outstanding rejections and filed an Information Disclosure statement.

DISCUSSION

The petition, file history and restriction requirement have been carefully considered.

At the onset, it is noted that an application filed as a national stage application under 35 USC 371 is eligible for unity of invention practice. The filing of a request for continued examination does not alter an application's eligibility for unity of invention practice. Any unity of invention requirement set forth in this application should be done so in accordance with PCT unity of invention practice. See PCT International Search and Examination Guidelines Chapter 10, published January 2004 and MPEP Chapter 1800, especially section 1893.

For this reason alone, the restriction requirement mailed 21 February 2008 was improper and will be withdrawn.

A couple other irregularities will be addressed next.

On February 21, 2008, the examiner withdrew already examined claims 17-51 (claims drawn to gelled culture mediums) from consideration because the examiner considered the claims to contain new matter. This was incorrect. The MPEP offers the following guidance on the addition of new matter:

> If new matter is added to the claims, or affects the claims, a rejection under 35 U.S.C. 112, first paragraph, using form paragraph 7.31.01 should be made. If new matter is added only to a claim, an objection using this paragraph should not be made, but the claim should be rejected using form paragraph 7.31.01. As to any other appropriate prior art or 35 U.S.C. 112 rejection, the new matter must be considered as part of the claimed subject matter and cannot be ignored.

While an examiner may object to a specification for containing new matter, any addition of new matter to a claim would require a rejection of the claims for new matter and additional consideration under the remaining statutes.

Moreover, by withdrawing the already examined claims from the restriction requirement groupings, the Office action mailed 21 February 2008 limited the scope of the claims by restriction and prevented applicant from electing the invention that had already been under examination. This is not appropriate.

When faced with the requirement to elect between the process of Group I or Group II, applicants elected Group I with traverse. However, in the next Office action, the examiner failed to examine their elected invention. This is counter to the following guidance in MPEP 818.03:

> Applicant must make his or her own election; the examiner will not make the election for the applicant. 37 CFR 1.142, 37 CFR 1.143.

The claims presented on March 23, 2005 and fully examined on July 31, 2006 are:

> 1. (currently amended) A culture medium for detecting meticillin-resistant microorganisms, comprising~~, besides~~ nutrients for the growth of said microorganisms, an antibiotic chosen from the group of second or third generation cephalosporins, and a chromogenic agent that releases a chromophore after hydrolysis with an enzyme that is active in said microorganisms.

6. (currently amended) The culture medium as claimed in claim 5, ~~characterized in that~~ wherein said antibiotic is ~~chosen~~ selected from the group consisting of cefoxitin, cefmetazole, moxalactam, cefotetan and flomoxef.

14. (currently amended) A method of detecting meticillin-resistant microorganisms in a sample, comprising the steps ~~consisting in~~ of:

(a)[[-]] inoculating a medium as claimed in ~~one of claims~~ claim 1 ~~to 12~~ with said sample or an inoculum derived from said sample,

(b)[[-]] incubating said medium under conditions that allow growth of said microorganisms,

(c)[[-]] detecting, on said medium, the presence of said meticillin-resistant microorganisms by virtue of the presence of colored colonies.

Claim 1, as pending on April 30, 2007 which had been examined and rejected recited:

1. (Currently Amended) A culture medium for detecting methicillin-resistant Staphylococci aureus (MRSA) directly from a sample from a patient or after an enriching phase, comprising:

nutrients for the growth of said Staphylococci aureus;

an antibiotic chosen from the group consisting of cefamandole, cefoxitin, cefmetazole, moxalactam, cefotetan and flomoxef; and

a chromogenic agent that releases a chromophore after hydrolysis with an enzyme that is active in said microorganisms MRSA.

The instantly pending claims filed on October 28, 2008 are:

17. (New) A gelled culture medium for detecting methicillin-resistant Staphylococcus aureus (MRSA), comprising:

nutrients for the growth of said Staphylococcus aureus;

an antibiotic added to the medium before the medium gels, wherein the antibiotic is cefoxitin, cefmetazole, or moxalactam; and

a chromogenic agent that releases a chromophore after hydrolysis with an enzyme that is active in said MRSA.

37. (New) A gelled culture medium for detecting methicillin-resistant Staphylococcus aureus (MRSA), comprising:

nutrients for the growth of said Staphylococcus aureus;

an antibiotic added to the medium before the medium gels, wherein the antibiotic is flomoxef; and

a chromogenic agent that releases a chromophore after hydrolysis with an enzyme that is active in said MRSA

52. (New) A method of detecting the presence or absence of methicillin- resistant Staphylococcus aureus (MRSA) in a sample from a patient, comprising:

(a) inoculating a medium comprising (i) nutrients for the growth of said MRSA; (ii) an antibiotic, wherein the antibiotic is cefoxitin, cefmetazole, or moxalactam; and (iii) a chromogenic agent that releases a chromophore after hydrolysis with an enzyme that is active in said MRSA, with said sample;

(b) incubating said medium under conditions that allow growth of said MRSA;

(c) detecting, on said medium, the presence or absence of said MRSA by virtue of the presence or absence of colored colonies

78. (New) A method of detecting the presence or absence of methicillin- resistant Staphylococcus aureus (MRSA) in a sample from a patient, comprising:

(a) inoculating a medium comprising (i) nutrients for the growth of said MRSA; (ii) an antibiotic, wherein the antibiotic is flomoxef; and (iii) a chromogenic agent that releases a chromophore after hydrolysis with an enzyme that is active in said MRSA, with said sample;

(b) incubating said medium under conditions that allow growth of said MRSA;

(c) detecting, on said medium, the presence or absence of said MRSA by virtue of the presence or absence of colored colonies.

As shown by the comparison above, the subject matter presently claimed is substantially comparable to the subject matter which had already been under examination.

Turning now to the election of species requirements, on 21 February 2008, the examiner required an election of a single antibiotic. However, during that examination, the examiner has already cited prior art for teaching the third generation cephalosporins which are specifically claimed, such as

cefoxitin and cefmetazole (see Aritaka in the Office action mailed 31 July 2006)
moxalactam (see Felten in the Office action mailed 29 January 2007)
cefoxitin, cefotetan or cefamandole (see Felten in the Office action mailed 29 January 2007)
cefmetazole (see Dorso in the Office action mailed 29 January 2007) and
flomoxef (see Hanaki in the Office action mailed 29 January 2007)

The examiner also required applicants to elect a single chromogenic agent and type of medium, where the medium further comprises one of vancomycin, telcoplanin and/or avoparcin, etc. However, these various types of limitations were already present in the claims that had been already examined.

For all these reasons, the restriction requirement mailed 21 January 2008 is improper.

DECISION

The petition is **GRANTED**.

The restriction requirement mailed 21 February 2008 is withdrawn.

Claims 29-30, 35, 37-98 are rejoined with the claims already under examination, and said claims will be examined together (Claims 17-98).

The application will be forwarded to the examiner for consideration of the papers filed 28 October 2008 and for preparation of a non-final Office action consistent with this decision.

Should there be any questions about this decision, please contact Special Program Examiner Julie Burke, by letter addressed to Director, Technology Center 1600, at the address listed above, or by telephone at 571-272-1600 or by facsimile sent to the general Office facsimile number, 571-273-8300.

Remy Yucel
Director, Technology Center 1600
jb/jg

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David W. Highet, VP and Chief IP Counsel
Becton, Dickinson and Company
(Finnegan Henderson)
1 Becton Drive, MC 110
Franklin Lakes, NJ 07417-1880

EXAMINER	
LILLING, HERBERT J	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.